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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 09/775,028 | 02/01/2001 | Jeffrey R. Spetalnick | 00704/RPM | 8286 |
| 1933 | 7590 | 12/28/2004 | | EXAMINER |
| FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023 | | | | RETTA. YEHDEGA |
| | | | ART UNIT | PAPER NUMBER |
| | | | | 3622 |

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 09/775,028 | Applicant(s) SPETALNICK, JEFFREY R. |
| | Examiner Yehdega Retta | Art Unit 3622 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed September 2, 2004. In response to the office action mailed March 10, 2004, applicant amended claims 1-15.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Wecker et al. U.S. Patent No. 6,256,614.

Regarding claim 1, Wecker teaches providing banner advertisements on websites; providing link to other website through the banner and providing rewards for clicking on the banner; Wecker teaches providing a banner advertisement of an advertiser on a first web site, and providing a reward to the user for clicking on the banner advertisement, and providing the

reward from a third party (see fig. 3&7, col. 8 lines 1-65, col. 9 line 48 to col. 10 line 30 and col. 11 line 48 to col. 12 line 10). Wecker teaches the web site providing a banner ad of an advertiser, which provide link to the advertiser (the company providing the survey and advertising for the drugs) providing reward from a third party (free long distance minutes) (see fig. 1A). According to Webster dictionary, an indicia is a distinctive mark, and Wecker discloses an indicia (image of a telephone), which indicates the reward provided being phone minutes. If applicant's claim of an "indicia" is a mark, such as a logo or trademark of a company, then Wecker does not teach such mark. However, providing a logo or indicia on the banner ad does not patentably differentiate the invention from the prior art, providing indicia is just a design choice. Matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re Seid*, 73 USPQ 431, 433 (CCPA 1947).

Regarding claims 2-12, Wecker teaches bringing the user to central website; determining if user is registered; determining if user previously clicked on the banner and preventing an award and providing a message to the user; checking cookie or password; permitting user at the central website to register and providing reward to the user; providing confirmation that the reward has been credited to the user account; permitting user to access account; wherein rewards comprise of airline reward miles or incentive bonus points (see fig. 3&7, col. 8 lines 1-65, col. 9 line 48 to col. 10 line 30 and col. 11 line 48 to col. 12 line 10).

Regarding claims 13-15, Wecker teaches providing a banner advertisement of an advertiser on a first web site, and providing a reward to the user for clicking on the banner

advertisement, the reward provided by a third party (see fig. 3&7, col. 8 lines 1-65, col. 9 line 48 to col. 10 line 30 and col. 11 line 48 to col. 12 line 10). Wecker teaches the web site providing a banner ad of an advertiser, which provide link to the advertiser (the company providing the survey and advertising for the drugs) and a third party (free long distance minutes) (see fig. 1A). According to Webster dictionary, an indicia is a distinctive mark, and Wecker discloses an indicia (image of a telephone), which indicates the reward provided being phone minutes. If applicant's claim of an "indicia" is a mark, such as a logo or trademark of a company, then Wecker does not teach such mark. However, providing a logo or indicia on the banner ad does not patentably differentiate the invention from the prior art, providing indicia is just a design choice. Matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re Seid*, 73 USPQ 431, 433 (CCPA 1947). Wecker teaches linking the banner advertisement to respective website; bringing user to central website; determining if user is registered; providing reward to registered user; providing message to user if user clicks on a banner that had previously clicked; checking cookie or password (see col. 8 lines 1-65; col. 9 line 48 to col. 10 line 30 and col. 11 line 48 to col. 12 line 10).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yehdega Retta
Primary Examiner
Art Unit 3622

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